

REMARKS

In the Official Action of December 8, 2006, claims 1 and 7 were rejected as being anticipated by the MacDonald patent and claims 1, 6, and 7 were rejected under 35 U.S.C. 102 as being anticipated by the Chamberland, *et al.* patent ("Chamberland"). Claims 2, 3, and 5 were rejected under 35 U.S.C. 103 over the Chamberland patent in view of Gribble, *et al.* ("Gribble"). Claim 4 was objected to and indicated as being allowable if rewritten in independent form to include all the limitations of the base and any intervening claims. The §102 rejections of claim 1 and 7 and of claims 1, 6, and 7 are respectfully traversed because neither the MacDonald nor Chamberland patents disclose all the elements recited in claims 1, 6, and 7. Applicant also respectfully traverses the §103 rejection of claims 2, 3, and 5 because the Action again fails to make out a proper *prima facie* showing of the obviousness of the differences between the claims and the combination of Chamberland and Gribble. Applicant therefore requests reconsideration of both the §102 and the §103 rejections. In accordance with the requirements of 37 C.F.R. 1.111(b), the basis for traversing these rejections is set out below.

First with regard to the §102 rejection of claims 1 and 7 over MacDonald, there are at least three elements recited in claim 1 that are not disclosed in MacDonald. Contrary to the allegation on page 2 of the Action, it does not appear that the lead wires is/are clamped or inherently retained in the shell of MacDonald by gripping or clamping. At the right-hand end of the apparatus disclosed in that patent (the thermocouple end), MacDonald specifically states (at col. 3, lines 2-5) that the insulator 25 around the wires 21 "is not fitted tightly within the steel tube, nor is there a tight connection between the longitudinal holes in the insulator and the wires 21." Instead, as set out in the very next paragraph of col. 3 of MacDonald, one end of the "wires 21 project beyond the ceramic tube, or . . . [insulator], and are twisted three full turns, as indicated at 27, to provide sufficient material for a fusion weld, or the wires may be formed to meet end to end to make a butt joint" and at the other end (the end located within the shell), the wires 21 are soldered or welded to the lead-in wires 13 (*see* col. 2, lines 52-56). At the left end of the apparatus disclosed in MacDonald, that patent states only that "[t]he sockets 28 [that receive the lead-in wires 13] terminate in a flat member 29 having openings 30 to facilitate the attachment of leads" (*see* col. 3, lines 21-22 of MacDonald) and says absolutely nothing about the clamping of the leads that are attached to the flat members 29.

Applicant is therefore unable to find any disclosure or description in MacDonald of the clamping of the wires 21 to the lead-in wires 13 or any other structure that is an integral portion of the shell. Applicant has taken note of the allegation in the middle of page 2 of the Action as to how MacDonald must inherently clamp so as to maintain the connection (soldering being an

electrical connection, not a mechanical connection), but respectfully traverses any allegation that MacDonald inherently discloses clamping. As set out at MPEP §2112 (third paragraph), when a §102 rejection is based “upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art [citation omitted, emphasis in original].” Applicant notes that the Action attempts to provide the required “basis in fact and/or technical reasoning,” with the allegation that because soldering is an electrical, not a mechanical, connection the lead wire must be retained in the shell to prevent damage to the soldered connection. However, as noted above, there appears to be absolutely no indication of clamping whatsoever in MacDonald, and the little disclosure contained in MacDonald that appears to have anything to do with the way that the wires are retained in the shell shown in that reference appears to teach the opposite of clamping (reference the language quoted above as to how the insulators 25 are not “tightly fitted within the steel tube, nor is there a tight connection between the longitudinal holes in the insulator and the wires 21”) such that it does not appear from the disclosure of that reference that the allegedly inherent characteristic (clamping) “necessarily flows from the teachings of” MacDonald. Note also that even if it is assumed for the purposes of argument (and Applicant does not so admit) that MacDonald clamps the lead wires, MacDonald does not even begin to disclose the location of the (undisclosed) structure for clamping the lead wires, so it cannot disclose the location of the ceramic disk in relationship to the wire clamp as recited in the second element of claim 1.

Because MacDonald does not disclose the structure recited in the first, second, or last paragraph of claim 1, Applicant respectfully requests the reconsideration of the §102 rejection of claim 1 over MacDonald. Likewise, reconsideration of the rejection of claim 7 over MacDonald is respectfully requested. That claim also recites a structural relationship between a clamp and the ceramic disk, and as noted in the last sentence of the preceding paragraph, even if MacDonald does inherently disclose clamping (which Applicant does not admit), it does not disclose the location of the clamp, and certainly does not disclose the location of the clamp relative to the claimed ceramic disk, so it cannot disclose the structure recited in claim 7.

Applicant is at a loss to understand what is happening with the §102 rejection of claims 1, 6, and 7 over Chamberland. In response to the rejection of these same claims over the same reference (in the Official Action of September 23, 2005) Applicant submitted evidence (the **Declaration of Troy K. Hopper**) and argument (**Applicant’s Response to Official Action of September 23, 2005**) showing that Chamberland does not disclose the structure recited in claim 1. In response to that evidence and argument, the §102 rejection over Chamberland was

withdrawn (see the comments on page 2 of the papers mailed by the Office on June 16, 2006). However, the Official Action of December 8, 2006 resurrects that same rejection, without any explanation as to why it is again being asserted and without the introduction of further evidence into the record to support that rejection, such that Applicant is unable to know how to proceed. Indeed, the rejection is made with exactly the same words and reasoning as set out in the September 23, 2005 Action such that it is as if Applicant never filed his **Response to Official Action of September 23, 2005** (and the Affidavit submitted with that Response). Applicant played by the rules, responding to the §102 rejection with argument and evidence (and the response was actually regarded as persuasive), and for that rejection to be renewed at this time without any indication as to a new basis for the rejection or the introduction of further evidence of unpatentability into the record effectively erects a stone wall against patentability that Applicant may never be able to overcome. If it was intended in the Action to reinstate the §102 rejection upon further consideration of the cited reference, it would have been helpful to see some indication in the Action as to the basis for the change of heart (*see* MPEP 706.04).

Instead of an indication that the §102 rejection had been reconsidered or that new evidence was being introduced into the record in support of the §102 rejection, Applicant finds only one sentence (on the penultimate page of the Official Action of December 8, 2006 in the section of the Action titled “Response to Arguments”) that does not appear to have been set out in any previous Action (and that is not even designated in the Action as relating to the rejection of claims 1, 6, and 7 such that Applicant is forced to guess at the reason for the change of heart on claims 1, 6, and 7), alleging that “[s]oldering could not preserve a mechanical integrity of the connection [sic].” The grammar of this sentence clouds the sentence enough that Applicant is uncertain of its meaning, but as noted above in connection with the discussion of the MacDonald patent, there is some evidence of record in this application that indicates that clamping may not be necessary to protect the mechanical integrity of a soldered connection. If this new sentence was intended as a basis for re-asserting the §102 rejection of claims 1, 6, and 7 over Chamberland, the evidence of record in the application indicates that this new sentence is not well grounded in fact and it is therefore respectfully urged that this rejection be reconsidered and withdrawn.

Applicant has previously pointed out the differences between Chamberland and claim 1 of the present application and those remarks (set out in Applicant’s **Response to Official Action of March 10, 2005** and **Response to Official Action of September 23, 2005**) are re-asserted in this Response as if fully set forth herein. To summarize, Chamberland does not disclose the wire clamps called out in the second and last elements of claim 1. Although it is alleged in the Action

that the metal sleeve 34 and insulator 36 of Chamberland constitute clamping means, it appears that sleeve 34 and insulator 36 “surround” a center conductor 18. Notwithstanding the dictionary definition reference on page 5 of the Action, “surrounding” is not clamping. Applicant submitted evidence (in the form of the **Declaration of Troy K. Hopper**) as to the meaning of the word “clamp” to those of ordinary skill in the art in the field of electrical connectors and noted specifically that any attempt to characterize an insulating jacket surrounding a conductor as shown in Chamberland as a clamp would be dismissed by one skilled in the art as the thinking of someone who is unfamiliar with the structure and function of electrical connectors (*see* paragraph 6 of the Hopper Declaration). Applicant also noted that a center conductor is not a lead or sensor wire as recited in claim 1 and that Chamberland was not likely to disclose means for clamping a lead wire since, as set out at col. 1, lines 38-44 of that patent, the invention described in that patent is intended to connect coaxial cables, not conductors/lead wires. Applicant also noted that because Chamberland does not disclose a clamp for a lead wire, it cannot disclose male or female conductive pins that extend through the claimed ceramic disk to a wire clamp and that it was inappropriate to analogize the claimed sleeve to the “forward portion of 26 with holes 26a” of Chamberland because the “first body 26” of Chamberland is part of the male connector (“plug”) 12 disclosed in that device.

Because of these several differences between the structure of Chamberland and the structure set out in claims 1, 6, and 7, it is submitted that the §102 rejection of claims 1, 6, and 7 is improper and that those claims should be allowed. Applicant again calls attention to the fact that claim 1 was actually amended in Applicant’s **Response to Official Action of March 10, 2005** to broaden that claim since it is allowable over Chamberland and the amendment to claim 1 set out in this Response is being made for that same purpose.

Just as the §102 rejection of claims 1, 6, and 7 was renewed without explanation or further evidence of unpatentability, the §103 rejection of claims 2, 3, and 5 was resurrected from the Official Action of September 23, 2005. The only way that Applicant can respond to this rejection, at least on the basis of the record in the captioned application at this time, is to again point out that the Official Action of December 8, 2007 fails to make out a proper *prima facie* showing of the obviousness of the differences between Applicant’s invention and the cited references. This shortcoming of the §103 rejection made in the December 8, 2006 Official Action is the same shortcoming identified in Applicant’s **Response to Official Action of March 10, 2005** and **Response to Official Action of September 23, 2005**, and those remarks are re-asserted here as if fully set forth in this Response. To summarize, Applicant noted the requirements set out in the second paragraph of MPEP §706.02(j), to the effect that “[t]o establish

a *prima facie* case of obviousness, three criteria must be met.” First, the rejection must indicate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP §706.02(j). A review of the December 8, 2006 Action indicates that it fails to establish a proper *prima facie* showing of the obviousness of the differences between the invention claimed in claims 2, 3, and 5 and the cited prior art references, alone or in the combination asserted in the Action.

Applicant previously pointed out that none of the Actions in the application to date makes out a *prima facie* showing of the obviousness of the differences between that claim and the cited prior art references because they have all failed to identify any disclosure in either of Chamberland or Gribble of a connector that combines a clamp for a lead wire, a conductive pin in electrical contact with the clamp for a lead wire, and a ceramic disk that is interposed between the claimed sleeve and wire clamp, all as recited in claim 1 (on which claims 2, 3, and 5 are dependent). The Official Action of December 8, 2006 makes no attempt whatsoever to identify such structure in response to Applicant’s argument and therefore fails to establish that the cited references, alone or in combination, teach the claimed structure as required by MPEP §706.02(j).

Applicant also pointed out that the references fail to provides a suggestion or motivation to modify or combine in the manner claimed. In response to Applicant’s point, the Official Action of December 8, 2006 alleges (at the middle of page 5) that

“it is generally known two basic types [sic] of wire connection – non-separable (soldering) and separable. Replacing non-separable connection [sic] with separable one [sic] requires the knowledge generally available to one of ordinary skill in the art. Reasons for replacement of the non-separable connection with separable one [sic] are related to dependability of the mechanical connection providing an uniform pressure [sic] for connection, manufacturing preferences, maintenance and repair needs.”

The grammatical irregularities make it difficult to understand this quotation from the December 8, 2006 Action. However, as Applicant noted in the **Response to Official Action of September 23, 2005**, the allegation that one of ordinary skill in the art could replace a separable connection with a non-separable connection does not provide the requisite suggestion that one **should** replace a non-separable connection disclosed in the prior art with a separable connection. In an apparent attempt to bolster this failing of this allegation of a suggestion to combine or modify in prior Actions, the December 8 Action adds references to “uniform pressure,” “manufacturing preferences,” and “maintenance and repair needs.” In response to these new thoughts, Applicant asks “**what** manufacturing preferences?” “**What** maintenance and repair needs?” (And what in

the world is intended by the reference to “uniform pressures”?) Why would these pressures, preferences, and needs have any bearing whatever on the type of connection that would be utilized by one of ordinary skill in the art? In the absence of some showing of a relationship between pressures, preferences, and needs and Applicant’s claimed structure, the pressures, preferences, and needs referenced in the Action are little more than random thoughts that are no substitute for the required reason or suggestion to modify or combine the references. It is therefore respectfully submitted that this attempt to show that the art teaches or suggests the claimed combination is insufficient to establish a *prima facie* showing of the obviousness of the differences between the claimed invention and the combination of the Chamberland and Gribble references, and reconsideration and withdrawal of the §103 rejection is therefore requested.

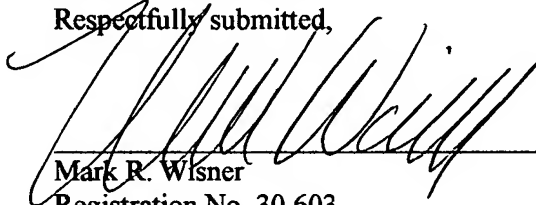
Applicant notes that even if the allegation quoted above from the December 8, 2006 Action does rise to the level of a *prima facie* showing of the obviousness of the differences between the claimed invention and the combination of the Chamberland and Gribble references (and Applicant does not so admit), evidence has been made of record (in the form of the Declaration of Troy K. Hopper) contradicting the allegation that replacing a non-separable connection with a separable connection is within the knowledge available to one of ordinary skill in the art. Specifically, paragraphs 8-10 of the Hopper Declaration explain why the two types of connections are not interchangeable and unambiguously state (paragraph 10) that in the context of Applicant’s invention, replacing a non-separable connection with a separable connection would compromise the function of Applicant’s invention. In light of that evidence, Applicant respectfully submits that the Official Action of December 8, 2006 does not establish a *prima facie* showing of a suggestion to combine the cited references and that it is incumbent upon the Office either to withdraw a §103 rejection or to come forward with new evidence in support of that rejection. In the absence of new evidence, Applicant requests reconsideration and withdrawal of the §103 rejection of claims 2, 3, and 5.

When there is no suggestion in the art to modify the references in the manner asserted, there can be no showing of the third element of a *prima facie* obviousness rejection, namely, an expectation of success. In the absence of a showing of (1) all the claimed elements in the cited art, (2) a suggestion in the art to modify the combined references in the manner claimed, and (3) some expectation that such a modification can be made successfully, the §103 rejection of claims 2, 3, and 5 is improper and should be withdrawn.

Entry of the above amendments to the claims, reconsideration and withdrawal of the §102 rejections of claims 1 and 7 and claims 1, 6, and 7, as well as the §103 rejection of claims 2, 3, and 5, consideration of the remarks set out herein, allowance of the claims, and passage of the

application to issuance are all respectfully requested. In the unforeseen event that there are questions and/or issues yet to be answered in this application, it is respectfully requested that Applicant's Attorney be contacted at the address and phone number set out below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark R. Wisner', is written over a horizontal line.

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